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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/775,980 | 02/09/2004 | Elizabeth M. Doherty | A-824 | 1288 |

7590 10/22/2004

U.S. Patent Operations/RVP
Dept. 4300, M/S 27-4-A
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Thousand Oaks, CA 91320-1799

EXAMINER

MORRIS, PATRICIA L.

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1625

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,980

Applicant(s)

DOHERTY ET AL.

Examiner

Patricia L. Morris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

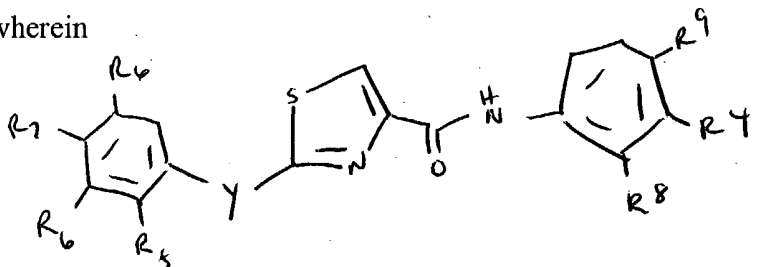
Claims 1 and 6 are under consideration in this application.

Claims 2-5 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restrictions

Applicant's election without traverse of Group I and the species of example 3 in the reply filed on August 12, 2004 is acknowledged.

This application has examined with regard to the elected compound and expanded to a genus wherein



Y, R⁴-R⁹ as set forth in claim 1, exclusively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niedermann et al. (US 5,693,594).

Niedermann et al. generically embrace the instant compounds wherein Y is oxygen and R⁴ represents halogen.

It is believed that one having ordinary skill in the art would have found the claimed compounds *prima facie* obvious, since they are generically embraced by the disclosed formula; *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See also *In re Malagari*, 499 F.2d 1297, 182 USPQ 549 (CCPA 1974); *In re Lemin*, 332 F.2d 839, 141 USPQ 814 (CCPA 1964); *In re Rosicky*, 276 F.2d 656, 125 USPQ 341 (CCPA 1960). The requisite motivation for arriving at the claimed compounds stems from the fact that they fall within the generic class of compounds disclosed by Niedermann et al. Accordingly, one having ordinary skill in the art would have been motivated to prepare any of the compounds embraced by the disclosed generic formula, including those encompassed by the claims.

It is believed well settled that a reference may be relied upon for all that it would have reasonably conveyed to one having ordinary skill in the art. *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); *In re Lamberti*, 545 F.2d 747, 192 USPQ 278 (CCPA 1976); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Susi*, *supra*.

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Further, the specific reference compounds, examples nos. 32, 33, 49(C), 49(D), 53, etc. differ from the compounds claimed herein as halogen analogs of the claimed compounds. One having ordinary skill in the art would have been motivated by the disclosure of the compound to arrive at other compounds within the claimed genus as well as at the claimed species. The motivation to make these compounds is their close structural similarities to the disclosed compound. While homology is considered to be present even if true "homology" is not present, such does not defeat the prima facie case of obviousness raised by the art. Attention, in this regard is directed to *In re Druey et al.*, 50 CCPA 1538, 319 F.2d 237, 138 USPQ 39, wherein Judge Worley, delivering the Court's opinion, stated:

that in "We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants the term homologue is used by chemists at times in a broad sense, and at other times a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." 50 CCPA 1541.

Also, as the Court stated in *In re Payne et al.*, 606 F.2d 302, 203 USPQ 245 at 255 (CCPA 1979):

"the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound."

In addition, any question of why would one conceive and use the similar compounds (i.e. "motivation") is answered by the Court in *In re Gyurik et al.*, 596 F.2d 1012, 201 USPQ 552 at 557.

"In obviousness rejections based in close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the prima facie case of obviousness, rises from the expectation that compounds similar in structure will have similar properties."

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Conclusion

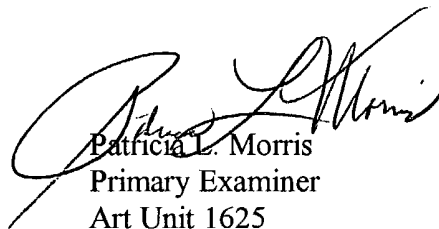
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688.

The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patricia L. Morris
Primary Examiner
Art Unit 1625

plm
October 21, 2004